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EXAMINER

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ART UNIT PAPER NUMBER

3632

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/851,639
Filing Date: May 09, 2001
Appellant(s): ADAMS, WILLIAM E.

Lynn J. Alstadt
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 12, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-10.

Claim 11 is allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 11, the prior art of Lee '087 divulged a holder and flag device comprising a suction cup having a cup portion and a neck extending from the cup portion wherein the neck contains a transverse bore, and a flag having a display portion attached to a pole. However, the prior art of Lee '087 failed to specifically teach a portion of the pole to have a multi-sided cross section complementary to a multi-sided cross section of the transverse bore such that when the portion of the pole is fitted within the transverse bore the flag can be rotated within the transverse bore from a first

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position to a second position wherein in each position every side of the portion of the pole is opposite a side of the transverse bore.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

Issue 1: This is no longer valid since claim 11 is now allowed.

Issue 2: As stated in the Examiner's office action mailed February 7, 2003, claims 1-4, 6 and 7 are rejected under U.S.C. 103(a) as being unpatentable over Rendall '996 in view of Brown '408, **not** Brown '408 in combination with Rendall '996 as stated by the appellant.

Issue 3: As stated in the Examiner's office action mailed February 7, 2003, claim 5 is rejected under U.S.C. 103(a) as being unpatentable over Rendall '996 in view of Brown '408, and further in view of Adams '865, **not** Brown '408 in combination with Rendall '996, Roberts '734 and Adams '865 as stated by the appellant.

Issue 4: This issue is listed correctly.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-10 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,323,996	Rendall	06-1994
4,506,408	Brown	03-1985
6,131,865	Adams	10-2000
5,078,356	Adams	01-1992

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rendall '996 in view of U.S. Patent number 4,506,408 to Brown.

Regarding claims 1, 3 and 6, Rendall '996 reveals a holder (figure 2) comprising a magnetic device having a magnet (38) and a neck with at least one bore comprising a single bore passing therethrough, and a split ring having two ends each fitted within the bore and each having a cross section complementary to that of the bore such that the split ring can be rotated within the bore from a first position to a second position such that in each position every side of the end of the split ring is opposite a side of the at least one bore. However, Rendall '996 fails to specifically teach the magnetic device to be a suction cup having a cup portion and a neck containing at least one bore.

Figure 7 of Rendall '996 divulges a holder comprising a rubber suction cup (103) having a cup portion and a neck with at least one bore and a split ring having two ends each fitted within the bore and each having a cross section complementary to that of the bore such that the split ring can be rotated within the at least one bore from a first position to a second position such that in each position every side of the end of the split ring is opposite a side of the at least one bore. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the magnetic device with a suction cup so as to reduce weight and manufacturing costs, in addition to providing for an alternate mounting means.

Moreover, Rendall '996 fails to specifically teach the cross sections of the at least one bore and two ends of the split ring to be multi-sided cross-sections.

Brown '408 divulges a holder (figure 9) comprising a member (72) rotatable within a bore wherein the member and the bore have complementary hexagonal cross-sections such that the member can be rotated within the bore from a first position to a second position such that in each position substantially every side of the member is opposite a side of the bore so as to effect variable positioning between the member and the bore. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the cross sections of the ends of the split ring and the at least one bore of Rendall '996 to be complementary hexagonal cross-sections as in Brown '408 (such that when the ring is rotated within the bore from a first to a second position, *inherently* every side of the end of the ring would be opposite a side of the at least one bore) so as to provide for a more sturdy holder by allowing the split ring to be more securely maintained in a desired position.

Regarding claim 2, Rendall '996 in view of Brown '408 fail to *specifically* teach the cross-sections to be square. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the cross-sections to have any number of sides, including four so as to be square shaped cross-sections, in order to meet the specific design needs of an operator.

With respect to claim 4, Rendall '996 in view of Brown '408 fail to *specifically* teach the cross-sections to be octagonal. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have increased the number of sides

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of the cross-sections so as to be octagonal cross-sections since doing so would be seen as simply a duplication of parts. See *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Alternatively, regarding claims 1, 3 and 7, Rendall '996 reveals a holder (figure 7) comprising a rubber suction cup (103) having a cup portion and a neck with at least one bore comprising a pair of bores on a common axis wherein each bore extends from an outer surface of the neck toward a center of the neck so that a web separates the two bores, and a split ring having two ends each fitted within the bore and each having a cross section complementary to that of the bore such that the split ring can be rotated within the at least one bore from a first position to a second position such that in each position every side of the end of the split ring is opposite a side of the at least one bore. However, Rendall '996 fails to specifically teach the cross sections of the at least one bore and two ends of the split ring to be multi-sided cross-sections.

Brown '408 divulges a holder (figure 9) comprising a member (72) rotatable within a bore wherein the member and the bore have complementary hexagonal cross-sections such that the member can be rotated within the bore from a first position to a second position such that in each position substantially every side of the member is opposite a side of the bore so as to effect variable positioning between the member and the bore. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the cross sections of the ends of the split ring and the at least one bore of Rendall '996 to be complementary hexagonal cross-sections as in Brown '408 (such that when the ring is rotated within the bore from a first to a second

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position, *inherently* every side of the end of the ring would be opposite a side of the at least one bore) so as to provide for a more sturdy holder by allowing the split ring to be more securely maintained in a desired position.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rendall '996 in view of Brown '408, and further in view of Adams '865.

Rendall '996 in view of Brown '408 divulge the previous invention failing to specifically teach the suction cup to specifically be made of soft vinyl or the ring to comprise polypropylene or polycarbonate. However, Adams '865 teaches a holder having a soft vinyl suction cup (column 4, lines 10-11) and a polycarbonate ring (column 3, lines 64-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to manufacture the suction cup and ring of Rendall '996 in view of Brown '408 of soft vinyl and polycarbonate, respectively, as in Adams '865 so as to provide for improved gripping strength of the suction cup, and to provide for a resilient but sturdy ring.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams '356 in view of Brown '408.

Adams '356 discloses a holder (figure 3) comprising a suction cup (26) having cup and neck portions, the neck containing a transverse bore, and a J-hook (18) having two ends, a portion thereof, having a head adjacent thereof, being fitted within the bore so that the hook can be rotated within the bore from a first position to a second position such that in each position every side of the portion of the hook is opposite a side of the bore. However, Adams '356 fails to specifically teach the cross sections of the bore and

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the portion of the hooked fitted within the bore to be complementary multi-sided cross sections.

Brown '408 divulges a holder (figure 9) comprising a member (72) rotatable within a bore wherein the member and the bore have complementary hexagonal cross-sections such that the member can be rotated within the bore from a first position to a second position such that in each position substantially every side of the member is opposite a side of the bore so as to effect variable positioning between the member and the bore. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the cross sections of the portion of the J-hook being fitted within the transverse bore and the transverse bore of Adams '356 to be square cross sections as in Brown '408 (such that when the ring is rotated within the bore from a first to a second position, *inherently* every side of the end of the ring would be opposite a side of the at least one bore) so as to provide for a more sturdy holder by allowing the J-hook to be more securely maintained in a desired position.

(11) Response to Argument

All arguments pertaining to the rejection of claim 11 are moot since claim 11 is now allowed.

All arguments concerning the Examiner's use of Roberts '734 are invalid since the Examiner did not rely on Roberts '734 in the most recent office action mailed February 7, 2003.

Beginning with the first full paragraph of page 4 of the Brief, the appellant contends "There is nothing in this reference (Rendall '996) to teach or suggest that the ends of these rings and hook or the bore have a multi-sided cross-section." This comes as no surprise to the Examiner; if Rendall '996 did suggest such multi-sided cross sections, the Examiner would not have needed to rely on a secondary reference for such a teaching.

In response to appellant's argument on the bottom of page 4 and top of page 5 of the Brief that Brown '408 is nonanalogous art, it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant's was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Rendall '996 and Brown '408 concern pivoting hinge type structures. Moreover, the invention of Rendall '996 certainly would not be destroyed by the modification of the teaching of Brown '408 since both concern hinge type structures wherein a member or an end having a multi-sided cross section is rotated within a bore having a complementary multi-sided cross section without removing the member or end from the bore during the rotation (in Brown '408 this is due to the resilient nature of the material surrounding the bore).

Regarding lines 7-8 of page 5 of the Brief, the fact that the Examiner did not introduce Brown '408 into the prosecution until the fourth office is completely immaterial to the appellant's argument.

Therefore, the Examiner's use of Rendall '996 in view of Brown '408 is surely not an improper combination of non-analogous art.

On lines 7-8 of page 6 of the Brief, the appellant contends that the action in Brown '408 is opposite to that of the present invention since in Brown '408 "the ridges or corners flex to allow rotation." This is not true. As discussed on lines 41-47 and 67-68 of column 2 of Brown '408, **one or both** of the "rib and groove set/structures" (member/end and bore as discussed by the Examiner) are made of a resilient material and hence "flex" as recited by the appellant.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

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Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, modifying the ends of the ring and the bore of Rendall '996 so as to have complimentary cross sections would clearly be advantageous since doing so would allow a user to position the ring in a multiplicity of sturdy positions, including any of those shown in the cited figures of Rendall '996, which would provide for a more conveniently adjustable device hence increasing the utility of the device.

The remaining arguments with respect to claims 5 and 8-10 have been essentially previously addressed.

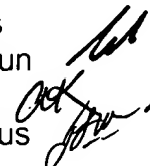
For the above reasons, it is believed that the rejections should be sustained.

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March 30, 2004

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